

REMARKS

This communication is filed in response to the Final Office Action dated October 26, 2010 (hereinafter "*Second Final Office Action*"). Claims 1, 6, 14, 18, and 28 are amended. Claim 27 is canceled. Claim 32 is added. Therefore, claims 1-9, 11-21, 23-25, and 27-31 remain pending in this application.

Impropriety of the Finality of the Second Final Office Action

The Examiner stated that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a)."¹ Applicants disagree. The section of the MPEP cited by the examiner states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). MPEP § 706.07(a).²

In a Final Office Action dated March 9, 2010 (hereinafter "*First Final Office Action*"), the Examiner rejected claims 1-25 as allegedly being unpatentable over U.S. Patent No. 6,954,757 B2 to Zargham et al. (hereinafter "Zargham") in view of U.S. Patent No. 6,081,807 to Story et al. (hereinafter "Story") and further in view of U.S. Patent No. 7,203,700 to Kumar (hereinafter "Kumar").³

On May 10, 2010, in a response to the *First Final Office Action* (hereinafter "*First Final Office Action Response*"), Applicants amended claims 6-13 merely to add a "non-transitory" element.⁴ In an Advisory Action dated June 3, 2010 (hereinafter "*Advisory Action*"), the Examiner maintained the rejection set forth in the *First Final Office Action*.⁵

¹ *Second Final Office Action* at 28.

² MPEP § 706.07(a).

³ *First Final Office Action* at 4.

⁴ *Final Office Action Response* at 8.

⁵ *See Advisory Action* at 2.

On July 8, 2010, in response to the *Advisory Action*, Applicants filed a pre-appeal brief request for review (hereinafter “*Pre-Appeal Brief*”). In a Notice of Panel Decision from Pre-Appeal Brief Review dated August 13, 2010 (hereinafter “*Notice of Panel Decision*”), the *First Final Office Action* was withdrawn.

In the *Second Final Office Action*, the Examiner rejected claims 1-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Zargham* in view of *Story* and further in view of U.S. Patent Application Publication No. 2002/0165727 to Greene (hereinafter “*Greene*”).⁶ In other words, the Examiner continued to maintain the rejection of claims 1-25 under 35 U.S.C. § 103(a), but replaced the *Kumar* reference, which the Examiner cited in the *First Final Office Action*, with the *Greene* reference, which the Examiner did not previously cite. The Examiner’s reliance on a previously uncited reference constitutes a new ground of rejection that was not necessitated by Applicants’ amendments in the *First Final Office Action Response*, in which Applicants merely added the “non-transitory” element to claims 6-13.

Because the Examiner raised a new ground of rejection that was not necessitated by Applicants’ amendment in the *First Final Office Action Response*, the office action following the *Notice of Panel Decision*, in which the *First Final Office Action* was withdrawn, should have been a non-final office action. Accordingly, Applicants respectfully request that the Examiner withdraws the finality of the *Second Final Office Action*.

The Rejection of Claims Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Zargham* in view of *Story* and further in view of *Greene*.⁷ As the Supreme Court stated in *KSR Int’l Co. v. Teleflex Inc.*,⁸ the factual inquiries announced in *Graham v. John Deere*⁹ (scope and content of the prior art; differences between the claimed invention and the prior art; level of ordinary skill in the art; and secondary indicia of nonobviousness), remain the

⁶ *Second Final Office Action* at 2. Note: Based on the substance of the *Second Final Office Action*, Applicants assumed the Examiner meant to reject pending claims 1-9, 11-21, 23-25, and 27-31 under 35 U.S.C. § 103(a).

⁷ *Second Final Office Action* at 2.

⁸ *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

⁹ *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966).

foundation of any determination of obviousness.¹⁰ It remains true that “[t]he determination of obviousness is dependent on the facts of each case.”¹¹ The teaching-suggestion-motivation (TSM) test was but one possible approach.¹² Furthermore, a prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness.¹³ Applicants will show that, under the facts of this case, independent claims 1, 6, 14, and 18, and their respective dependent claims, are not obvious over *Zargham* in view of *Story* and further in view of *Greene*.

Independent claim 1, as amended, recites, in part,

a plurality of instances of an application server coupled in a star topology with the message server at a center of the star topology, the message server handling communications between the plurality of instances of the application server.

In support of an assertion that *Zargham* teaches or suggests a portion of a similar recitation, specifically, “a plurality of instances of an application server implementing a Java application model coupled in a star topology with the message server at a center of the star topology,” the Examiner cited to *Zargham* at col. 3, lines 21-26. This portion of *Zargham* states:

It is further noted that the ZLE framework defines a multilevel architecture with a hub, wherein the enterprise applications are loosely coupled to the hub and communicating therewith via adapters.

Thus, *Zargham* discusses that “enterprise applications” communicate with a hub via adapters. However, *Zargham*’s discussion of enterprise applications communicating with a hub does not teach or suggest “a message server handling communications between *[a] plurality of instances of [an] application server*,” as recited in independent claim 1. In fact, the “enterprise applications” discussed in *Zargham* are not equivalent to the “*plurality of instances of the*

¹⁰ See Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*, Federal Register / Vol. 75, No. 169 / Wednesday, September 1, 2010 / Notices, p. 53644 (hereinafter “2010 KSR Guidelines”).

¹¹ *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1089 (Fed. Cir. 2008) (citing *Graham*, 383 U.S. at 17–18 (1966)).

¹² See Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 FR 57526 (Oct. 10, 2007), 1324 Off. Gaz. Pat. Office 23 (Nov. 6, 2007) (hereinafter “2007 KSR Guidelines”).

¹³ See, e.g., *In re Gurley*, 27 F.3d 551, 554 (Fed. Cir. 1994); MPEP § 2145(X)(D)(1).

application server” recited in claim 1. For example, the discussion in *Zargham* of how enterprise applications communicate with one another does not teach or suggest any mechanism for how a plurality of instances of application servers may communicate with one another.

Elsewhere, *Zargham* discusses a “workflow service” that is, for example, an Enterprise Java Bean (EJB) “running on parallel, available application servers.” However, the phrase “parallel, available application servers” is not equivalent to “a plurality of instances of application servers,” as recited in independent claim 1. For example, multiple application servers may run in parallel without being instances of an application server. In fact, *Zargham* does not mention the word “instances” at all, much less “a plurality of instances of application servers,” as recited in independent claim 1.

Moreover, even if *Zargham*’s mention of “parallel, available application servers” could somehow be construed as being equivalent to “a plurality of instances of an application server,” *Zargham* does not teach or suggest a mechanism by which such parallel, available application servers communicate. Again, as mentioned above, *Zargham* merely mentions that enterprise applications communicate with a hub via adapters; *Zargham* does not teach or suggest that “parallel, available application servers” communicate by such a mechanism.

Therefore, for at least the above reasons, *Zargham* does not teach or suggest “the message server handling communications between the plurality of instances of the application server,” as recited in independent claim 1.

Independent claim 1, as amended, also recites, in part,

one or more of the plurality of instances to register or reregister instance-specific information with the message server upon starting or restarting, respectively, of the message server, the instance-specific information including an instance number, the instance number identifying the associated instance to the message server.

The Examiner conceded that “[t]he modified *Zargham* [that is, *Zargham* in view of *Story*] does not disclose a similar recitation.”¹⁴ However, in support of the assertion that *Greene*

¹⁴ *Id.* at 5.

discloses this similar recitation, the Examiner cited to *Greene* at paragraphs [0129]-[0135].¹⁵ The cited paragraphs of *Greene* discuss a “VM container” that “must register itself to be visible to clients, services, and administrators in the enterprise that may need the VM container for running a service.”¹⁶ However, a VM container is not equivalent to “one or more of the plurality of instances [of an application server],” as recited in independent claim 1. For example, *Greene* does not teach or suggest that a “VM container” is an *instance* of a particular entity, much less an *instance of an application server*.

Furthermore, although *Greene* discusses that the VM container must register itself to be visible to clients, *Greene* does not teach or suggest that that the VM container registers with a *message server*. Instead, *Greene* discusses that the VM container “must register itself with a domain registrar and/or enterprise repository.”¹⁷ Here, *Greene* does not teach or suggest that the domain registrar or enterprise repository “handl[es] communications between the plurality of instances of the application server is equivalent to a message server,” as recited in independent claim 1. Therefore, neither the domain registrar nor the enterprise repository is equivalent to a *message server*.

Moreover, *Greene* does not teach or suggest “register[ing] or reregister[ing] instance-specific information . . . including an instance number, the instance number identifying the associated instance to the message server,” as recited in independent claim 1. Instead, *Greene* merely discusses that “[w]hen a service registers itself, it provides a number of attributes in the registration that makes it easier for other (potential consumers) to find.”¹⁸ However, *Greene*’s discussion of registering of such attributes does not teach or suggest registering an “instance number identifying the associated instance to the message server,” as recited in independent claim 1. Thus, *Greene* describes the registration of a *service*, which is distinct from the registration of an *instance of an application server*, consistent with claim 1. For example, whether a service registers information that clients can use to find the *service* is irrelevant to whether an *instance of an application server* registers an instance number that identifies the

¹⁵ *Second Final Office Action* at 4.

¹⁶ *Greene* at [0136].

¹⁷ *Greene* at [0130].

¹⁸ *Greene* at [0187].

instance of the application server to a message server (e.g., an entity that is separate from the clients).

Independent claims 6, 14, and 18 recite claims limitations similar or analogous to those discussed above with respect to claim 1, and it is thus submitted that these claims are also non-obvious. In addition, any claim depending from a non-obvious independent claim is also non-obvious.¹⁹ Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-25 under 35 U.S.C. § 103(a).

Each of independent claims 1, 6, 14, and 18 also recites “a message server having no persistent state such that the message server can be restarted after a failure without performing state recovery operations.” The Examiner conceded that *Zargham* does not disclose this recitation.²⁰ Instead, the Examiner cited various portions of *Story* in support of the assertion that *Story* teaches this recitation.²¹ However, *Story* teaches away from this recitation. In particular, *Story* states that “there are problems associated with implementing a stateless file server” because “operating-system mechanisms to support [traditional file access]” are “stateful.”²² *Story* further states that “on many operating systems, to have to recreate this state information for each read or write operation adds significant system overhead and reduces system performance to an unacceptable degree.”²³

Thus, *Story* discusses creating a “pseudo-open” state for a file “when a request for accessing the file is received.”²⁴ To that end, *Story* states that if “there is no pseudo-open state established for the file, the pseudo-open state will be established [when the request is received].” Because *Story* expressly disparages the concept of a stateless server that does not establish a pseudo-open state corresponding to each server request, *Story* teaches away from a server that “can be restarted after a failure *without performing state recovery operations*,” as recited in each of independent claims 1, 6, 14, and 18 (emphasis added). Accordingly, claims 1-9, 11-21, 22-25,

¹⁹ See MPEP § 2143.03.

²⁰ *Second Final Office Action* at 4.

²¹ *Id.* at 5.

²² *Story* at col. 50, lines 50-56.

²³ *Id.* at col. 1, lines 56-59.

²⁴ *Id.* at col. 2, lines 32-35.

and 27-31 are non-obvious for this additional reason.

The Examiner also asserted:

It would have been obvious to one of ordinary skill in the art at the time to create the invention of Zargham to include the stateless server as taught by Story et al. in order that "if a client makes a request to a server, and after satisfying that request the server fails and is restarted, the server must be able to handle subsequent related requests from the client without needing to access state data that was lost when the server failed." (Column 1 lines 35-39).²⁵

Applicants respectfully disagree that it would have been obvious to one skilled in the art at the time of Applicants' invention to have combined any of the teachings of *Story* with any of the teachings of *Zargham*. *Story* is directed to "[a] method and apparatus for interfacing with a stateless NFS (Network File System) server."²⁶ In contrast, *Zargham* is directed to "allow[ing] the enterprise to integrate its services, applications and data in real time."²⁷ *Zargham* does not mention a file system, much less an NFS file system, and *Story* does not mention integrating services, applications and data in real-time. Thus, *Story* and *Zargham* are non-analogous art.

The Examiner also asserted:

It would have been obvious to one of ordinary skill in the art at the time to create the invention of the modified Zargham to include registering of instances as taught by Greene in order that "Once running, a VM container must register itself to be visible to clients, services and administrators in the enterprise that may need the VM container for running a service" (Paragraph [0136]).²⁸

Applicants respectfully disagree that it would have been obvious to one skilled in the art at the time of Applicants' invention to have combined the teachings of *Greene* with any of the teachings of *Zargham*. For example, *Greene* states:

²⁵ *Second Final Office Action* at 4.

²⁶ *Story* at Abstract.

²⁷ *Zargham* at col. 2, lines 21-22.

²⁸ *Second Final Office Action* at 6.

Various approaches have been applied in an attempt to achieve ubiquitous access to data. One approach is to maintain all of the data in one central location. As the amount of data grows, this approach rapidly leads to a bottleneck at the servers as many "clients" attempt to simultaneously access the body of data. Furthermore, the remote access to the data requires a communications infrastructure and may consume considerable bandwidth.

Thus, *Greene* expressly disparages the idea of clients using a communications infrastructure to access data in one central location. This teaching of *Greene* is directly contrary to *Zargham*'s teaching of, at least, "enterprise applications" that communicate with a hub via adapters. Accordingly, because *Greene* teaches away from *Zargham*, one skilled in the art at the time of Applicants' invention would not have combined *Greene*'s teachings with *Zargham*'s teachings.

CONCLUSION

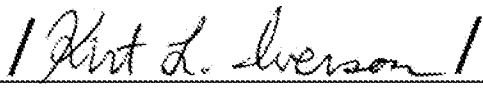
Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is contacted Applicant's representative by telephone (408-660-2016) or email (kiverson@slwip.com) to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 12/22/2010

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